Jurisdiction.

See petition and brief on application for writ of certiorari in this case, No. 809, October Term, 1929.

Statement of the Case.

This is an equity suit, limited on certiorari (R. p. 418) to infringement by Respondents (R. p. 1 to 13, 98, 99, 100, 101, 116) of petitioner's patents No. 1,379,224, claims 1 and 2 (R. p. 1 to 13, 83, 116, 171 to 177) and No. 1,507,440 (R. p. 1 to 13, 83, 116, 178 to 186) relating to devices used for dog-racing in pursuit of a mechanical lure.

Temporary injunction was granted but withheld upon respondent's furnishing $20,000.00 bond for stipulated damages in case it should be finally decided that respondents have infringed any one of the claims (R. pp. 44, 45); which bond was filed (R. pp. 46, 47, 48, 49). Respondents answered denying validity of the patents and their infringement of the claims (R. pp. 51, 59 to 76). Special Master was appointed to hear and determine the issues and report thereon (R. p. 77). At the hearing before the Master, the patents were assumed valid, treated as such by the parties and the Master (R. pp. 83, 84), the real issue being that of infringement of the claims (R. p. 84); and after taking testimony (R. p. 119 to 170) the Master filed his report finding infringement (R. p. 79 to 101). Respondents excepted to the Master's Report solely on the issue of infringement (R. p. 101 to 115). The exceptions were overruled and an appropriate decree approving the Master's Report and adjudging infringement and ordering payment of liquidated damages stipulated

(R. p. 116 to 118) from which decree respondents appealed (R. p. 387).

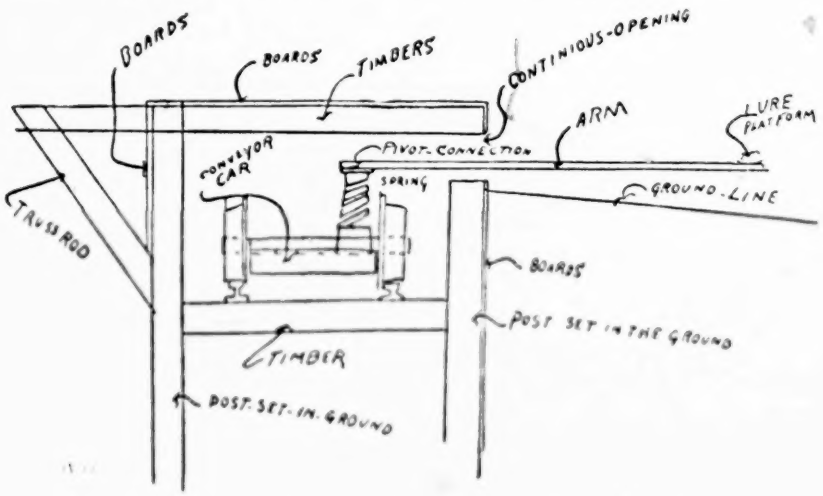
In reversing the decree, dismissing the bill and discharging the stipulated damage bond (R. p. 405 to 416) the Tenth Circuit Court of Appeals assumed that Patent No. 1,379,224, claims 1 and 2, were valid but not infringed (R. p. 405 to 410); and that if Patent No. 1,507,440 is valid, none of its claims are infringed (R. pp. 410, 411).

Summary as to Patent No. 1,379,224, Claims 1 and 2.—In his specifications, patentee Smith states that the invention consists of the arrangement and combination of parts described and claimed, and while the invention is not restricted to the exact details of construction disclosed, yet for the purpose of illustrating a particular embodiment thereof reference is had to the accompanying drawings (R. pp. 171, 172); and in the arrangement of the lure-carrying arm, that it is hinged to the conveyor car and supported at its outer end by a rotatably mounted wheel (R. pp. 173, 174). Claims 1 and 2 substantially describes the invention.

Claim 1. "In a dog racing amusement (1) a race course suited for dogs; (2) a casing extending around the outer side of the race course and provided with a longitudinal opening; (3) a mechanical conveyor including a track extending around the race course and located within the casing; (4) and a conveyor car mechanically operated upon said track and provided with an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure; (5) and a wheel rotatably mounted on and supporting the arm at the projecting end thereof." (R. p. 176).

Claim 2. "In an amusement, the combination (1) of a race track suited for dogs; (2) a covered rail track adjacent said course on one side; (3) a conveyor car mechanically operated on said track; (4) a horizontally extending arm hinged to said car extending midway of said course; (5) a wheel rotatably mounted near the end of said arm, and resting on the ground; (6) a platform supported by said arm, and (7) a lure or quarry mounted upon said platform for attracting the dogs." (R. p. 176).

Plaintiff's Exhibit No. 5 (side folio 177-178 opposite R. p. 186; see also R. pp. 187, 125, 127, 128) is here illustrated in cross section view of Respondents' apparatus:



(Note). The words "posts set in ground, boards, timbers, truss rod and continuous opening" exhibit the construction of the casing provided with a continuous longitudinal opening; the words "pivot connection" exhibits rigid support of the horizontal lure-carrying arm; the word "arm" exhibits the arm extending from the conveyor car through the longitudinal opening of the casing in a projecting position over the "ground line" (track), and the words "lure platform" exhibits the platform supported by the arm and the lure mounted on the platform.

Comparison of Claims 1 and 2 with Respondents' apparatus discloses an appropriation of the claims, except that Respondents' arm is rigidly supported on the car during the race, in lieu of the wheel support described and claimed in the patent.

(See also R. pp. 35, 39, 40; Master's Report, R. pp. 86, 87, 88, 97, 98; R. pp. 120, 121, 122, 126; Defendants' Exhibits Nos. 30, 31, 32, side folio 465-466, 467-468, 469-470, opposite R. p. 386; R. p. 171 (side folio opposite R. p. 170, 159-160, 161-162); R. p. 176; see also Defendants' Exhibit No. 2, side folio 211-212, 213-214, opposite R. p. 208; R. pp. 157, 164, 167, 168). Respondents' apparatus is located on the left-hand side of the race course opposite to the right-hand side thereof, and Respondents' rigidly supported arm is retracted into the casing at the termination of the race by means of trip or trigger mechanism whereby the lure is made to disappear, whilst the arm and lure of the patent is made to disappear into the casing by means of switching the car after the race is run. (See above references to the printed record).

Summary as to Patent No. 1,507,440, Claim No. 1.—The claim is: "in a housing for covering tracks and cars having laterally extending arm operated on said track, the combination of (1) posts set in the ground at the sides of said track; (2) timbers attached to said posts to form a frame; (3) boards attached to said timbers and posts to form a continuous enclosure above said track; (4) and having a continuous opening in one side of said housing

adapted to permit extension of the laterally extending arm therethrough; (5) and truss rods attached to the closed side of said housing adapted to support the side of said housing above the said continuous opening." (R. p. 180). Claims 2 and 3 provide for adjustable stay rods and adjustable screw threaded stay rods (R. pp. 179, 180). In his specifications, the patentee states, that the invention relates to means for concealing the track and conveyor car in a mechanical lure conveyor for dog-racing courses (R. p. 178) and the object is that of concealing the track and conveyor car from the dogs (R. p. 179). He further states that the invention is not restricted to the exact details of construction, but for the purpose of illustrating a particular embodiment reference is had to the accompanying drawings (R. p. 179).

Comparison of the above illustrated cross section view of Respondents' housing with Claim 1 of the patent, shows a literal translation of that claim. (Side folio 177-178 opposite R. p. 186; R. pp. 34, 36, 38, 40, 89, 90, 122, 127, 128).

Specifications of Error.

The Tenth Circuit Court of Appeals erred in finding and holding:

(1) That Patent No. 1,379,224, claims 1 and 2 are not infringed by Respondents.

(2) That Patent No. 1,507,440, claim 1, is not infringed by Respondents.

(3) That the judgment and bond for stipulated damages are void.

Argument.

Summary of Argument as to Patent No. 1,379,224, Claims 1 and 2.—Considering the high rank of this patent in the art to which it relates, these claims are entitled to generous treatment and to a range of equivalents commensurate with the scope of invention; that having described and claimed his device in his preferred form, the patentee is entitled to all other forms which embody the substance of a lure-carrying arm horizontally extending from the conveyor through the continuous longitudinal opening of the casing located on either outer side of the race course; that in their appropriation, Respondents have, by interchange, substituted for the preferred form of supporting said arm by movable or wheel support, the form of supporting said arm rigidly, without breaking up or essentially varying the principle and mode of operation pervading the original invention; that said preferred movable or wheel support is neither a distinguishing characteristic of the device nor essential to its patentability nor material to its operation; that said wheel support finds its mechanical equivalent in Respondents' form of rigid support of the patentee's arm, in that, either pertains to the working environment of the aforesaid inventive step, accessorial thereto and a matter of engineering selection; that no limitation is imposed on the patentee by the prior art, no disclaimer of equivalents for his said preferred form either in the specification, claims or Patent Office proceedings.

Accordingly, for a reversal of the decision below, it is urged:

Point A. Said patent (Claims 1 and 2) is entitled to a liberal construction and to a range of equivalents commensurate with its scope.

Point B. Substitution of a rigid for the wheel support of the horizontal arm and locating the device on the left outer side of the race course, does not avert infringement.

Point C. Patent Office proceedings discloses no express limitations of patentee's preferred form.

Summary of Argument as to Patent 1,507,440, Claim 1.—Considering that Respondents' housing device contains all the elements of the claim in the same combination constituting identity of function, operation, and result, for ground of reversal of the decision below, it is urged:

Point D. Patent No. 1,507,440 is valid.

Point E. Respondents have infringed Claim 1 of Patent 1,507,440.

Summary of Argument as to Stipulated Damage Bond.—Considering that Respondents voluntarily acquiesced in the order of the District Court withholding the temporary injunction by stipulating for the damages suffered by petitioner (plaintiff) and furnished bond to indemnify plaintiff for such damages; and considering that by the terms of said order and bond the same were limited to damages and not to Respondents' profits; that no evi-

dence of record justifies the conclusion that said bond was voluntarily given as a subterfuge for Respondents' profits, whether legally or illegally derived; it is urged as ground for reversal:

Point F. The decision below reversing the decree of the District Court is erroneous.

Point A.

Patent No. 1,379,224 (Claims 1 and 2) is entitled to a liberal construction and to a range of equivalents commensurate with its scope.

(a) Preliminarily, we approach this point from the prior art. "Coursing" is the ancient British sport of pursuing hares or other game with greyhounds when the game is started in sight of the hounds. Century Dictionary; New International Encyclopedia; Webster's New International Dictionary (Merriam Ed. 1927) p. 518; New Encyclopedia Brittanica 14 Ed. Vol. 6 p. 602; R. pp. 17, 18, 124, 135, 136. Retaining all of the exciting features of the sport of "Coursing" but eliminating the cruelties connected with the use of an animal victim as O. P. Smith says (R. p. 384), Hind (British) in 1884 (R. p. 300), Pinard in 1887 (R. p. 290), Moss (British) in 1896 (R. p. 398), Walsh in 1898 (R. p. 294), O. P. Smith in 1912 (R. p. 381) and Everett in 1913 (R. p. 297), by their patents proposed to inaugurate the use of artificial lures for greyhound racing.

Hind 1884 (R. p. 300, Defendants' Exhibit No. 11, side folios 335-336, 337-338) shows an inanimate lure travelling along a sunken tube or trough. Pinard 1887 (R. p. 290,

Defendants' Exhibit No. 8, side folios 319-320, 321-322) proposed a lure-carrier sliding or rolling on the ground connected with cable reeled in by a drum, said cable engaging anchored pegs along the course to give a zig-zag motion to the lure. Moss 1896 (R. p. 398, side folio 486) exhibits a device comprising a rail laid upon the race course, a flanged wheel mounted thereon, a motor geared to said wheel, said motor forming part of and carried by the lure, a trolley above said rail and adapted to supply electrical current to the motor as well as to support the mechanism by contact with a superimposed grooved pulley. He employs a small "hood" of insulating material designed to cover the trolley wire for protecting the dogs, for he says: "To avoid any danger from the dogs coming in contact with the live trolley wire, I cover the full length of the wire with a hood 28 of wood or other non-conducting material" (R. p. 401). As the dogs could only come in contact with the live trolley wire while running under it, this protection is useless since no provision is made for protecting the racing dogs against injury by striking their legs against the rail operating in the same plane as the trolley wire.

Each of the foregoing exhibits are devoid of applying the principle of guiding or carrying the lure by means of an arm.

Next in point of time is Walsh 1898 (R. p. 294, Defendants' Exhibit No. 9, side folio 325-326). He proposes two race courses susceptible of being used together or alternately. Each race course is separated, as to one by a

right outer fence and as to the other by a left outer fence. Between each fence and adjacent thereto he places his track and conveyor car. To protect both dogs and his travelling merchanisms and to conceal the merchanisms from the racing dogs, these fences must be high enough to prevent the dogs from leaping over the fences, and that necessitates the employment of an arm extending upwardly and outwardly vertically inclined in transverse direction to reach over and clear the respective fences. It further necessitates, as shown, a connection at the end of this vertically inclined arm, of another arm similar to a forearm (whether pliant as by the use of a cable or stiff by use of a rod or pole) extending vertically downward to a lure-carrying mat dragging on the ground. (R. p. 295, side folio 325-326 opposite R. p. 294). All this involves the situation of having his angular or elbowed arms operating in relatively vertical planes. Due to the awkwardness of his angular arm in its relation to the car, high speeds involved and the curves encountered, a problem in mechanics and in the law of centrifugal force is presented but not solved, in view of the absence of evidence that it ever worked experimentally or otherwise. O. P. Smith 1912 (R. p. 381 Defendants' Exhibit No. 29 side folios 457-458, 459-460) closely followed by Everett 1913 (R. p. 297 Defendants' Exhibit No. 10 side folios 329-330, 331-332) each involving the use of an underground tunnel located within and under the race course, an opening through the top, a conveyor car located in the tunnel and provided with a vertical arm extending through the opening on the outer end of which arm a lure is mounted.

Aside from the possibilities of short circuiting due to moisture in the tunnel, the impracticability of these two devices is obvious, for the opening must be wide enough to permit the vertical arm to freely pass and in that condition the dogs' toes would catch in the opening bringing about a crippling of the racing dogs thereby stopping the race or if too narrow to protect the dogs from being thus injured, there results a jamming of the arm and the consequent wrecking of the car enclosed in the tunnel, to say nothing of the delay affecting the patience of dogs and spectators during repair and removal of the wreck.

With the exception of Walsh, the uncontradicted opinion of the expert is, that the devices of Pinard, Moss, Smith 1912 and Everett are dog crippling apparatuses, and in other respects impractical and inoperative (R. pp. 119, 120, 122, 123, 124, 166, 167) and that Walsh's device is likewise impractical and inoperative at the required high speed. (R. pp. 166, 167).

(b) Smith proposed a radical departure in principle. (R. p. 171). He connected the two necessary cooperating elements of conveyor car and lure by an arm horizontally extending over the race course, and from conveyor to lure in closest proximity as fundamentally necessary to a practical functioning at high speed. Retaining this basic idea as indispensable, he had to overcome the difficulty of concealing the travelling conveyor from dogs and spectators without in any way affecting the application of the principle. The prior art presented an impassable barrier; so he surmounted it by placing the pro-

tecting fence on the far side of the rail track conveniently and relatively distant from the nearest side of the race course, thence from its upper portion by carrying it over to and directly in front of the outer side of the race course leaving a continuous opening for the free operation of his horizontal arm. In all this he produced function never performed before, terminating in a new and useful result never achieved before—a successful and complete dog race in pursuit of an inanimate lure. (Compare *Smith v. Springdale Amusement Park*, 39 Fed. 92, at pages 93 and 94, where the District Court concedes "that Smith was the first to realize that the lure could be carried upon the end of a horizontally extending arm" and that "it vitalized the whole device, etc." "Practically, all the elements of the combination co-operated in the final result, the accomplishing of a successful and safe race," p. 94). [redacted]ption of this principle or mode of operation pervading the invention has not been varied by Respondents is conceded.

But under *Sec. 4888 U. S. Rev. Stat.* Smith was required to embody that principle in what he considered the best mode; and in his specifications and drawings he describes his best mode, reserving unto himself all other modes or forms by declaring that the described and claimed invention "is not restricted to the **exact** details of construction disclosed herein, yet for the purpose of illustrating a **particular** embodiment thereof, reference is had to the accompanying drawings". (R. p. 172). This reservation thus carried into his claims is tantamount to claiming his device **substantially**, though not exactly, as described. (*Winans v. Denmead*, 15 How. at pages 342, 343; *Western Electric Co. v. La Rue*, 139 U. S. 601, 606). In

other respects that was unnecessary (*United States v. Societe, etc.*, Cail 224, U. S. 309, 328) for he teaches how to practice his invention in his preferred form by describing and claiming his horizontal arm as being hinged (Claim 2 R. p. 176, R. p. 173, side folio 161-162 member 25) to the conveyor car, and near or at its outer end supported by a wheel rotatably mounted (R. p. 174, lines 1, 2, 3); in short, that the wheel supports the hinged arm; and further, that the casing be located on the exterior or grandstand outer side of the race course as distinguished from its interior or infield outer side (R. p. 172, side folio opposite R. p. 170). As Respondents support Smith's arm by a rigid in lieu of the preferred wheel support and transfer his casing from the preferred right outer side to the left outer side of the race course, the question is, does the substitution and transfer avoid infringement of either Claim or both.

(c) We believe that this patent exhibits the application of a principle in dog racing devices theretofore unseen and new elements and functions not thought of or found in the prior art whereby a result dreamed of but never achieved culminated in the first successfully operating apparatus evidencing "the important but long delayed and therefore not obvious step", and on the basic idea of which all subsequent devices must necessarily depend. *Hildreth v. Mastoras*, 257 U. S. 27, 34; *Westinghouse v. Boyden*, 170 U. S. 537; *Diamond Rubber Co. v. Consol. Rubber Co.*, 220 U. S. 428, 434, 435, 436; *Hobbs v. Beach*, 180 U. S. 383, 399.

Smith's application for patent was filed in September, 1919, (R. p. 171); and whilst the burden is on Respondents, they have failed to show that any thing or any body produced an operatively successful device or complete dog race of this character, experimentally or otherwise. *Hildreth v. Mastoras*, 257 U. S. 27, 33; *Caffin v. Ogden*, 85 U. S. 120. Petitioner (plaintiff) produced evidence in negation. From Hind in 1884 to Smith in 1921 is 38 years. The prior art shows that for over a third of a century others have tried, patents have issued, but nobody ever succeeded or used them or attained any operative success. And it is undisputed that prior to this Smith 1921 patent application, to be exact prior to 1920, dog-racing in pursuit of an inanimate lure was unknown (R. pp. 17, 22, 23, 24, 27, 25, 40, 135, 158). The only evidence of an attempt was made by Smith in 1910 or 1912 when he sought to get a dog race out of his 1912 patent; that attempt resulted in operative failure and was abandoned (R. pp. 119, 120, 122, 123, 124, 129). Prior to 1920, Smith was a poor man (R. p. 18) and since that time he has been regarded in the sport which he has thus created by his patent as the original inventor of successful dog-racing apparatus employing an artificial lure. (R. pp. 17, 18, 22, 23, 24, 26, 27, 29, 30, 40). This new sport sprang into existence and its popularity maintained in widely separated parts of this country and elsewhere, engaging capital and labor, improving the breed and increasing the value of greyhounds—all as a direct result of the operative success of the patent. (R. pp. 18, 19, 20, 21, 22, 23, 24, 26, 28, 29, 30, 31, 38, 40, 41, 42, 43, 129). Added recognition is given by tribu-

tary inventors who claim an addition or improvement only for retracting his horizontal lure-carrying arm into his casing after the race is run, to an inoperative position. (See Creveling Patent 1924, R. p. 214, Defendants' Exhibit No. 4, side folios 217-218, 219-220; Shaughnessy Patent 1927, R. p. 209, Defendants' Exhibit No. 2, side folios 211-212, 213-214); *American Electric Rabbit, etc., v. Smith*, 26 Fed. (2nd) 1016; *Smith v. American Electric Rabbit, etc.*, 21 Fed. (2nd) 366, 371). It is believed that the character of the invention falls within the criteria established in *Hildreth v. Mastoras*, 257 U. S. 27, *supra*, and kindred decisions.

(d) On the other hand, enough is revealed so as to convince even those who are prejudiced against the art, that Smith's claims are to be liberally construed (*Eibel Process Co. v. Minnesota Co.*, 261 U. S. 45, 63) and he "is entitled to a reasonable range of equivalents measured by the advance he has made over older machines and is not limited to the specific form claimed and described, unless he has expressly so limited himself, or unless such limitation is necessary in order to save his patent from anticipation". *McSherry Co. v. Dowagiac Co.*, 101 Fed. 716, 721 (C. C. A. 6) per Taft, Lurton and Day, C. J.); *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405; *Dowagiac Mfg. Co. v. Minnesota Moline Co.*, 118 Fed. 136, 140, 141, (C. C. A. 8). The prior art never taught or suggested Smith's step, nor was any advance made in the usefulness of his device; nor has he expressly limited himself to the form claimed and described, as is shown by his specifications, nor by the Patent Office proceedings hereinafter reviewed in Point C.

Point B.

Substitution of a rigid for the wheel support of the horizontal arm and locating the device on the left outer side of the race course does not avert infringement.

(a) That these two forms are equivalents in the opinion of experts is not contradicted. (R. pp. 121, 122, 39, 40, 33, 35, 36). It is confirmed by the Patent Office experts as shown by the Creveling File Wrapper (R. p. 187, Plaintiff's Exhibit No. 8; 194, 197, 198, 203). Creveling specifically claimed every element of Patent 1,379,224 in his first claim "and a lure-supporting arm **sustained** on the car and extending through the slot of the housing to position the lure within the race track" (R. p. 194). This claim was rejected on Smith No. 1,379,224 (R. p. 197). The element was again repeated by way of amendment, thusly: "and a lure-supporting arm **sustained** on the car for movement over the race track" (R. p. 198). The Patent Office again rejected this Claim on May 9, 1923, stating "Claim 1 is again rejected on Smith of record in which every feature of the Claim is clearly disclosed in the same relation and performing the same function". (R. p. 201). Thereupon Creveling acquiesced by cancelling lines 6, 7, 8 of his Claim 1 reading "and a lure-supporting arm sustained on the car and extending through the slot etc.", (R. p. 203), and so amended the claim as to claim and exhibit his true invention, for retracting Smith's arm into his casing after the race to an inoperative position. (R. p. 203).

Indeed, the Patent Office proceedings of this Patent, hereinafter reviewed, sufficiently shows that, by the in-

terchange, no quality of invention or novelty is involved in selecting a form of support, as that is in the common field of mechanical construction. See also *Thomson-Houston v. Athol*, 91 Fed. 767, 765 (C. C. A. 1) quoting with approval *Thomson-Houston v. Athol*, 83 Fed. 203 (C. C.) and recognized in *Commissioners Decisions 1897*, p. 694, where it was held, that to support a working part, whether rigidly or elastically, any mechanical engineer must select and as he may select either, such selection is mechanical skill. Respondents have merely transferred the support at the projecting end of the arm into its connecting end on the car without in any manner varying the principle, mode of operation or result. (R. p. 35). (*Sanitary Ref. Co. v. Winters*, 280 U. S. 30). The change was therefore a question of degree in the use of substantially the same means. (*Brush v. Condit*, 132 U. S. 27, 39).

Applying the test of interchangeability or non-interchangeability (*Miller v. Eagle Mfg. Co.*, 151 U. S. 208), the arm may be, in fact is, used in either apparatus whether supported rigidly or movably while the apparatus is in operation, for there is no radical unfitness, no radical change in function or result, merely a change in form; since the element of support pertains to the working environment of the inventive step consisting of the horizontal-lure-carrying-arm extending through the casing. Accordingly, changes in form or construction of parts will not avoid infringement where the principle or mode of operation of the patent is taken; or where the changed form or construction is neither the distinguishing characteristic, nor material to the device or its operation. *Winans v. Denmead*, 15 How. 342; *Burr v. Duryee*, 1 Wall. 531, 573;

Sewall v. Jones, 91 U. S. 171; *Ives v. Hamilton*, 92 U. S. 426, 431; *Robertson v. Blake*, 94 U. S. 728, 734; *Seymour v. Osborne*, 11 Wall. 516, 560; *Elizabeth v. Pavement Co.*, 97 U. S. 126, 137; *Machine Co. v. Murphy*, 97 U. S. 120, 125; *Marsh v. Seymour*, 97 U. S. 348, 359; *Hoyt v. Horne*, 145 U. S. 302, 308; *Hobbs v. Beach*, 180 U. S. 383, 401; *Sanitary Ref. Co. v. Winters*, 280 U. S. 30; *Auto Vacuum v. Sexton*, 239 Fed. 898 (C. C. A. 2); *Litson v. Alaska*, 130 Fed. 129, 142, 143 (C. C. A. 9); *McSherry v. Dowagiac*, 101 Fed. 716, 722 (C. C. A. 6); *Metallic Extraction v. Brown*, 104 Fed. 345, 353 (C. C. A. 8); *Dowagiac v. Minnesota Moline Plow*, 118 Fed. 136 (C. C. A. 8); *Lourie v. Lenhart*, 130 Fed. 122, 129 (C. C. A. 8); *Wayne v. Benbow Brammer*, 168 Fed. 271, 278 (C. C. A. 8); *Adam v. Folger*, 120 Fed. 260 (C. C. A. 7); *Vroonan v. Penhallow*, 179 Fed. 296 (C. C. A. 6); *Wellman v. Cramp*, 3 Fed. (2nd) 531, 533 (C. C. A. 6); *Yancey v. Enright*, 230 Fed. 641 (C. C. A. 5); *Reece v. Globe*, 61 Fed. 958 (C. C. A. 1); *Kings County &c. v. U. S. Consol. &c. R. Co.*, 182 Fed. 59, 63 (C. C. A. 9); *Angelus v. Wilson*, 7 Fed. (2nd) 314 (C. C. A. 9). *Walker on Patents*, Sixth Edition, Sec. 419, Vol. 1, p. 517.

(b) In his testimony, witness Keen says that he had known Smith since 1909, (R. p. 119), but that he was away from him from about 1916 to about September, 1925. (R. p. 122). There is no evidence of Keen having any contact with Smith within two years prior to filing his application for patent on September 4th, 1919, (R. p. 171), or from 1916 to 1925. So, when Keen testifies that "Mr. Smith built cars with rigid arms and had the arms snap off on him and that is why he went to the wheel and

hinge" (R. p. 125), in the absence of other evidence as to dates, the witness was evidently referring to what he had seen or had been told by Smith subsequent to 1925. Keen's testimony in this regard is given prominence in the opinion below and construed as implying that Smith had determined the rigid arm to be "impractical" or "unworkable", and in consequence, the wheel support constituted the invention. This is error. Besides, no account is taken by the opinion that crystallization of the rigid arm consequent on car vibration and having a tendency to snap off depends to some extent upon the quality and kind of material used as well as the length of the arm. Nowhere is it shown and nobody has said, according to this record, that the rigid arm is unworkable or impracticable, or that the dead Smith had so regarded it. Expert Keen, in his testimony says that both forms are equivalents, (R. pp. 121, 122, 39, 40) and in his opinion the wheel support is **best,** because it adds less friction to the car, avoids crystallization of the arm from car vibration and there is **less chance** of the arm snapping off than in the employment of a rigid arm (R. pp. 122, 125, 126). But that testimony or Smith's preference ought not to be extended so as to mean, as the learned Court says, that the rigid arm was found by Smith to be "unworkable" or "impracticable" and from that statement conclude that the primary and substantial function of the wheel support was not support as stated in the specifications and claim, but was described and claimed for the purpose of avoiding crystallization and snapping off. The specification points out the best mode; the Court should have so concluded in view of *Section 4888, U. S. Revised Statutes,* which requires the inventor to state in his description the mode which he contemplates to

be the best. *Walker on Patents*, 6th Ed., Vol. 1, Sec. 160, pp. 188, 189; *Morey v. Lockwood*, 8 Wall. 230; *Continental Paper Bag v. Eastern Paper Bag, etc.*, 210 U. S. 405, 418; *Vroonan v. Penhollow*, 179 Fed. 296, 302. This is elementary, and the foundation of the doctrine of equivalents; so that whether the rigid arm works better or worse is of no consequence. *Winans v. Denmead*, 15 How. 342; *Hoyt v. Horne*, 145 U. S. 302, 308, 309; *Brush v. Condit*, 132 U. S. 39-50; *Marsh v. Seymour*, 97 U. S. 348, 359; *Murray v. Detroit Wire Co.*, 206 Fed. 465, 468 (C. C. A. 6); *Nathan v. Howard*, 143 Fed. 889 (C. C. A. 6); *King Axe. v. Hubbard*, 97 Fed. 795 (C. C. A. 6); *Woodward v. Boston Lasting Co.*, 60 Fed. 283 (C. C. A. 1); *Yancey v. Enright*, 230 Fed. 641 (C. C. A. 5); *Scheible Co. v. Clark*, 217 Fed. 760, 770, 771 (C. C. A. 6); *Temco v. Apco*, 275 U. S. 319, 328.

We believe that the vice of the opinion, not only lies in shutting the eye to the Statute, but in incorporating into the specification and claims, an express limitation which is not there and thus restrict the claims to a blind literalism. To expose the error we invoke the Statute and the decisions hereinbefore cited, as also *Walker on Patents* (6th Ed.), Vol. 1, p. 501, Sec. 412.

(c) The opinion below agrees with the "contention" (R. pp. 157, 160, 161; R. p. 126) of Respondent Shaughnessy, a former employee of Smith (R. pp. 21, 25, 27, 28, 30, 32, 135, 151, 153, 154, 158) by declaring that Smith's adoption of his aforesaid best mode for practicing the invention served the purpose of avoiding crystallization and consequent breaking of the arm whereas defendant's rigid arm answers a distinctly different purpose,

that of causing the lure to bounce about more nearly simulating a hare in flight, and from this, the opinion concluded that the substantial function performed by the wheel and hinge (is) not served by the rigid arm. (R. p. 409, *Magic City v. Smith*, 38 Fed. (2nd) 172, 173). The answer is, first, that the claims are not limited to a lure in the form of a stuffed hare, a ball or a handkerchief will do; and second, that since the asserted purpose is not set forth in the description or claims, one does not escape infringement by a double or analogous use (*Western Electric v. LaRue*, 139 U. S. 601) or by the fact that the offending device lacks one of the purposes or functions of the patented device where such purpose or function is not claimed in the patent (*Western Electric v. LaRue*, 139 U. S. 601; *Hoyt v. Horne*, 145 U. S. 302, 308, 309; *Hobbs v. Beach*, 180 U. S. 383, 401; *Litson v. Alaska*, 130 Fed. 129, 142, 143, C. C. A. 9) or that it performs the primary function of supporting the arm in substantially the same manner (*Ibid.*) or by adding to or taking from the patented device, or even by making it more or less efficient while retaining its principle and mode of operation and attaining its results by the same or equivalent mechanical means. (See authorities hereinbefore cited). Indeed, the asserted purpose gives significance to the change as colorable. *Sanitary Ref. Co. v. Winters*, 280 U. S. 30; *Smith v. American Electric Rabbit*, 21 Fed. (2nd) 366, *Ibid.* 26 Fed. (2nd) 1016.

(d) Respondents argued below in line with a suggestion of the District Court in *Smith v. Springdale Amusement Park*, 39 Fed. (2nd) 92, 94, 95, that regardless of Smith's reservation in his specifications and the re-

servation accorded him by law as to form and location, the preferred form of wheel support claimed, considered in connection with Smith's escape for the lure and the preferred location of the apparatus on the right outer side of the race course, is nevertheless reduced to a voluntary limitation on the theory advanced that if the track was slightly banked at the curves, the lure would perceptibly leave the ground at such curves and in direct proportion to the angle of banking, and this accounts for the wheel support implying flexibility and the location of the apparatus on the right outer side, with the asserted conclusion that the arm rigidly supported would not work on the right outer side of the race course at the curves (39 Fed. [2nd], pp. 94, 95, *supra*).

The specification and claims are not limited to an oval shaped race course having two outer sides, though that form is illustrated and described as one of several; it includes a rectangular or straight-of-way course, and the straight-of-way section of the illustrated oval course, as to which, the foregoing theory is inapplicable; and yet, the use of the rigid arm will nevertheless infringe at some stage of its operation it not being necessary that it should infringe at all stages. *Sewall v. Jones*, 91 U. S. 171; *Hoyt v. Horne*, 145 U. S. 302, 308; *Farrington v. Haywood*, 35 Fed. (2nd) 628, 631 (C. C. A. 6).

The statement that the lure would perceptibly leave the ground on the curves because of banking is, we think, inadvertant, unless the angle of the banked railbed is disproportioned to the angle of the banked course-bed; for what is meant is, that the lure on the end of the rigidly

supported arm would travel closer to the ground at the curves on that side and leave the ground at the curves on the other side, since the rigid arm assumes the same inclined position as the car, produced by the banking of the railbed. On the other hand, it is inadmissible (and without any engineering authority or evidence) to bank the course-bed around the curves so as to fit the assumption, which we believe is opposed to the appropriate manner of construction under given conditions. For the hypothesis fails to take into consideration the length of the arm and the importance of grades of course-bed and railbed, so indispensable in engineering practice. The unchanging position of the moving rigid arm relative to the course-bed is regulated and proportioned around the curves according to suitable grades of course-bed and railbed. By raising the desired grade of the railbed and lowering the desired grade of the course-bed, the angle of banking the railbed at the curves has practically no effect upon changing the extending position of the rigid arm relative to the bed of the course. No evidence was introduced by either party; these details of designing the railbed and course-bed for cooperation with the rigidly supported arm is purely a matter for the engineer; it is outside the patent. With the movable support of the arm, no raising of the railbed or lowering of the course-bed is required, which may or may not account for Smith describing and claiming this subordinate element in the mode he considered best for the application of his principle and the functioning of his fundamental cooperating elements. In view, therefore, that the wheel support of the arm, implying flexibility, furnished an accessory to his underlying invention, the liberal rather than the strict rule of equivalency obtains, especially in the Sixth

Circuit. *Wellman v. Cramp*, 3 Fed. (2nd) 531, 533 (C. C. A. 6); *Safety Automatic v. Edwards*, 7 Fed. (2nd) 92, 94 (C. C. A. 6); *Bundy v. Detroit*, 94 Fed. 521, 538 (C. C. A. 6); *McSherry v. Dowagiac*, 101 Fed. 716, 722 (C. C. A. 6).

Nor is the preferred form affected or converted into a voluntary limitation by Smith's means in providing an escape of the lure into the casing at whatever desired point on either side of the course. The claims are not concerned with this feature; on the other hand, the escape is effected by switching the conveyor car, and obviously, whether the wheel support or the rigid support of the arm is used, the car may be switched anywhere, in the straight-of-way or around the curves, on either side. This is manifest. (R. p. 121).

(e) With respect to placing the apparatus on either outer side of the race course, the Fifth and Tenth Circuit Courts of Appeal are substantially in accord. (R. p. 409; *Magic City, etc. v. Smith*, 38 Fed. (2nd) 170, 173; *American Electric Rabbit, etc., v. Smith*, 26 Fed. (2nd) 1016, and *Smith v. American Electric Rabbit, etc.*, 21 Fed. (2nd) 366, 369.

As shown in the specifications and drawing, the apparatus is preferably located on the right outer side, (see drawing, side folio opposite R. p. 170), the offending device being located on the left outer side. Not having expressly limited himself to any one outer side, the transposition is unsubstantial, (*Smith v. American Electric Rabbit, etc.*, 21 Fed. (2nd) p. 369, and cases there cited), there being no change in function, operation or result.

Point C.

Patent Office Proceedings disclose no express limitations of patentee's form.

(a) On review of the File Wrapper (R. p. 220), it appears that rejected original, amended and revised or new Claims 1 and 2 (R. pp. 220, 227, 231, 233, 235, 237, 238, 239, 240) relate to and claim an armless lure conveyor similar to Pinard (R. p. 290, side folios 319-320, 321-322) and Moss (R. p. 398, side folio 486) and a housing for concealing it, the ground of rejection being that as Moss was provided with a housing, it would not be invention to provide a housing for an armless lure conveyor as claimed in rejected original, amended and revised or new Claims 1 and 2 (R. pp. 237, 238, 240; R. p. 401, side folio 486). As these two rejected, amended and revised claims are not concerned with the claims in suit or the offending device, it is to inquire whether or not Smith's special reservation contained in his specifications (R. p. 172) and the reservations accorded him by law (*United States v. Societe Anonyme, etc., Cail*, 224 U. S. 309, at page 328, and cases there cited) as to his preferred form of supporting his horizontal arm by a wheel support, has, notwithstanding the reservation, been restricted to that form only or otherwise reduced to an express limitation as to form by way of estoppels contained in the File Wrapper.

That inquiry brings us to rejected original as amended and allowed Claim No. 3. (R. pp. 228, 231, 233, 234, 237, 238, 239, 240). Original Claim No. 3, reads as follows:

> "3. In an amusement, the combination of (1) a race track suited for dogs, (2) a covered rail

> track adjacent said course, (3) a conveyor car mechanically operated on said track, (4) **an arm attached to said car extending midway of said course,** (5) **a wheel rotatably mounted on said arm,** and (6) a lure mounted on said arm." (R. p. 228).

This original claim 3 was rejected on Walsh 611, 876, October 4th, 1898, (R. p. 231). As the Examiner "contents himself with a reference, we look to the matter referred to, to ascertain his meaning." *(Vroonan v. Penhollow*, 179 Fed. 296, 305 [C. C. A. 6]; *Frey v. Marvel*, 236 Fed. 916, at page 922 [C. C. A. 6]). Turning to the Walsh patent (R. p. 294, side folio 325-326), we find a race track suited for dogs, an uncovered rail track adjacent said course, a conveyor car mechanically operated upon said track, **an arm attached to said car extending midway of said course;** but we do not find a covered rail track or a wheel rotatably mounted on said arm or a lure mounted on said arm. Accordingly, the necessary inference from the Examiner's objection was, that there is neither invention nor novelty in supporting an extending arm by a wheel rotatably mounted (C. D. 1897, p. 694). Uninformed of the specific ground of objection, Smith amended the claim still retaining, "an arm attached to said car extending midway of said course", and "a wheel rotatably mounted on said arm", so as to read as follows:

> "Claim 3. In an amusement, the combination of (1) a race track suited for dogs, (2) a —rail track adjacent said course, (3) a conveyor car mechanically operated on said track (4) **an arm attached to said car extending midway of said course,**

> (5) **a wheel rotatably mounted on said arm,** (6) a lure mounted on said arm— and a casing extending around the race course and receiving and concealing the track and the conveyor car and provided with a longitudinal opening through which the said arm extends." (R. pp. 233, 234).

In presenting this amendment, Smith's attorney remarked "Claims (2 and) 3 against which the Walsh Patent was cited have (has) been amended to include the housing extending around the track and concealing the mechanical conveyor. This element is not present in the Walsh Patent." (R. 235). As thus amended, the claim was again rejected in these words: "Claims 1, 2 and 3 are rejected on either Walsh or Moss, both of record. Moss is provided with a housing and it would not be invention to provide Walsh with one." (R. p. 237). From this rejection, it is clear, the Examiner then considered that the claim read on Walsh and it constituted neither invention nor novelty, to encase Walsh's conveyor car having "an arm attached to said car extending midway of said course"; and furthermore, the twice repeated inclusion of "a wheel rotatably mounted on said arm" involved neither invention nor novelty, but a detail, mechanical selection or form of supporting an extending arm insufficient to distinguish it from the art of record, otherwise the claim would have been allowed as a patentable improvement on Walsh.

Although the Examiner limited his objections to the Walsh Patent and to housing his conveyor car having an extending arm, it is apparent that Smith's attorney broadly claimed an extending arm irrespective of its angu-

larity or an arm extending upwardly, outwardly and thence downwardly, as in Walsh, or whether it operated in a vertical plane, whereas the gist of Smith's invention, its fundamental element, principle and mode of operation was the straight out lure—carrying arm laterally extending and operating exclusively in a substantially horizontal plane. Accordingly, this original claim 3 as amended was cancelled (R. p. 237) and a new claim propounded as follows:

> "3. In a dog racing amusement, (1) a race course suited for dogs, (2) a casing extending around the outer side of the race course and provided with a longitudinal opening, (3) a mechanical conveyor including a track extending around the race course and located within the casing, (4) and a conveyor car operated upon said track and (5) provided with an arm extending **through** the longitudinal opening of the casing **in a projecting position over the track** and adapted to carry a lure, (6) and a wheel rotatably mounted on and supporting the arm at the projecting end thereof". (R. p. 238).

In his remarks, Smith's attorney challenged the Examiner to point out a casing as called for in either of the three claims, for he says: "Applicant is unable to find such a casing in the British patent to Moss and the Examiner is respectfully requested to apply the references to the extent of pointing out where this housing is shown". (R. p. 239). To which challenge, the Examiner responded as follows: "Case reconsidered as amended Nov. 10, 1920, Claims **1 and 2** are again rejected on Moss. The housing of Moss is Member 28. The remaining claims appear allowable." (R. p. 240).

Right here, as already observed, Claims 1 and 2 merely claimed a housing or casing extending around the race course receiving and concealing the conveyor car (R. p. 237, 238), and made no claim for a casing provided with a longitudinal opening as in Claim 3, nor did Claims 1 and 2 claim an extending arm at all; but these Claims 1 and 2 contemplated and claimed an armless mechanical conveyor as in Pinard and Moss. This affords the reason why the Examiner rejected Claims 1 and 2 (R. pp. 237, 238, 240) and accepting the challenge he said: "The housing of Moss is member 28. The remaining Claims (Claims 3, 4, 5, 6) appear allowable." Again turning to the Moss Patent (R. p. 398, side folio 486; R. p. 401), member 28 is a "hood" protecting a trolley wire within the race course proper and sinuously extending around it but not on either of its outer sides; nor does this "hood" show a longitudinal opening. In consequence, whilst the Examiner rejected Claims 1 and 2, he allowed Claim 3 (R. p. 240) and after adjustment of the numerals (R. p. 240) the allowed Claim 3 became Claim 1 of the Patent. (*Hildreth v. Mastoras*, 257 U. S. 27, 33, 34).

Parenthetically, in the rejected and original Claim 3 and as amended, the wheel support is included and reads: "A wheel rotatably mounted on said arm", whilst in allowed Claim 3, it reads "a wheel rotatably mounted on and supporting the arm at the projecting end thereof". (Compare R. pp. 228, 233, 238). This is a mere change of expression having substantially the same meaning, although not required by the Examiner, but in view of the specifications, that change in expression clarifies the clause according to the description (R. p. 174, lines 1, 2, 3) in that

the function of the wheel is to support the arm (*Hubbel v. United States*, 179 U. S. 77, at page 80).

Now, comparing this allowed Claim 3 (R. p. 240) with rejected Claim 3 (R. pp. 228, 231) as amended (R. pp. 233, 234, 237) it is clear, that in the rejected original and amended Claim 3, the arm element was broadly claimed, thusly: "an arm attached to said car extending midway of said course". That clause plainly and broadly covered an arm vertical or verticallly inclined and operating in a vertical plane as in Walsh (where his extending upper portion of the arm reached upwardly in transverse direction vertically inclined to clear his fence and his jointed forearm directed vertically downward) as well as a horizontally extending arm and operating in a horizontal plane, as in Claim 4 of the File Wrapper, Claim 2 of the Patent. Evidently, the Examiner had this distinction in mind during the course of his examination, and it was not until the contested Claim 3 was framed to restrict the **position** of the arm as extending **through** the longitudinal opening of the casing in a projecting position **over** the track, that the claim was allowed. Herein lies the dominating element, so recognized by the Examiner in his allowance of Claim 3.

Smith's attorney at all times insisted that the casing provided with a longitudinal opening and in which the conveyor car and tracks were located and co-operating with the arm was new, and although the examiner had by his rejection of amended Claim 3 disagreed, nevertheless he finally yielded to Smith's insistence as shown by his final rejection of Claims 1 and 2 and his final allowance of Claim 3. But aside from the Examiner's concession, Re-

spondent's device contains that and all the fundamental co-operating elements, the departure from the letter of the claim consisting in the form of supporting the arm.

Nowhere in the File Wrapper, or in the prior art or in the specifications, is there to be found anything whereby the Patent Office or the patentee had regarded the wheel support of the arm as exclusive of all other forms of support or as constituting it a distinguishing characteristic. Smith at no time was required to limit himself to a wheel support in order to secure the allowance of his claims. *Bundy v. Detroit, etc.*, 94 Fed. 524, 542, 543 (C. C. A. 6). Accordingly, the element of wheel support of the arm remains unaffected as to the patentee's preferred form, freed from the charge of an express limitation, separable from the substance and pertaining solely to the working environment of the inventive step. *(Bundy v. Detroit, supra).*

Reduced, therefore, to a final analysis, the difference between rejected and as amended Claim 3 and allowed Claim 3, is clearly defined. By the rejections and Smith's acquiescence therein, he has disclaimed broadly an extending lure-carrying arm attached to the conveyor car, whereas by the allowance he has limited himself to a lure-carrying arm extending through the longitudinal opening of the casing in a projecting position over the track, nowhere to be found in the prior art. This is the limiting effect of the rejection, and reading directly on Respondent's device. For since estoppels must rest on a definite basis, the familiar rule followed in *I. T. S. Rubber Co. v. Essex*, 272 U. S. 429,444, and kindred decisions does not carry over; nor does it contemplate a net result as a limi-

tation on every element in the allowed claim; nor does it resolve the patented device or an accessorial element claimed in the preferred form into a disclaimer of all other forms, particularly where that preferred form is outside the grounds of rejection or not controlled by the references of the prior art. *Crown Cork & Seal Co. v. Sterling*, 217 Fed. 381, at pages 390, 391, 392 (C. C. A. 6); *Vroonan v. Penhollow*, 179 Fed. 296, 305 *et seq.* (C. C. A. 6); *Wayne v. Benbow-Brammer*, 168 Fed. 271, 278, 279 (C. C. A. 8); *National Hollow B. B. Co. v. Interchangeable Co.*, 106 Fed. 693, 713, 714 (C. C. A. 8); *Bundy v. Detroit, etc.*, 94 Fed. 524, 543; *Hildreth v. Mastoras*, 257 U. S. 27, 33, 34. In short, the estoppel is co-extensive with the disclaimer and no further, for "to be estopped by the action of the Patent Office, the patentee must be shown to have surrendered something which he **now** claims in order to obtain that which was allowed". *Bundy v. Detroit, supra.* Smith was never required to surrender anything except as stated; and when we limit him to the lure-carrying arm extending through the continuous longitudinal opening of the casing in a projecting position over the track we have given to the rejections of claim 3 every effect that is required.

This conclusion is recognized by the Fifth Circuit Court of Appeals in *American Electric Rabbit, etc., et als., v. Smith*, 26 Fed. (2nd) 1016, agreeing with the conclusions of the District Court in *Smith v. American Electric Rabbit, etc., et als.*, 21 Fed. (2nd) 366, at page 371. It is likewise recognized by the Tenth Circuit Court of Appeals in its opinion below respecting Respondents' asserted limitation as to the location of the casing around the outer side

of the race course where "it was argued that Claim 3, as applied for, was rejected, and later allowed when the location was limited by amendment to the 'outer side' ". (R. p. 410); *Magic City Kennel Club v. Smith*, 38 Fed. (2nd), at page 173; and after stating the familiar rule citing *I. T. S. Rubber Co. v. Essex*, 272 U. S. 429, and other cases, that Court found and held that "the Patent Office made no decision on the question of location of the casing" * * * "The matter of location was not adjudicated, and the cited cases do not apply". (R. p. 410); *Magic City Kennel Club v. Smith*, 38 Fed. (2nd) at page 173.

True, the reasoning of that correct finding and holding as to the location of the casing is in discord with the Court's reasoning and conclusion respecting Smith's preferred form of supporting the arm wherein the Court said: "The Patent Office never questioned the patentability of the device of a horizontal arm hinged to the car and resting on a wheel" * * * "no amendment suggested as to that feature" * * * and from which the Court concluded: "The law laid down in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 425, 444, 47 S. Ct. 136, 141, 41 L. Ed. 335, is applicable that 'if the claim to a combination is restricted to specified elements all must be regarded as material.' " (R. pp. 409, 410, *Magic City, etc., v. Smith*, 38 Fed. [2nd] pp. 172, 173). The conclusion is manifestly *non sequitur*, unless qualified by "equivalency".

As no question was raised in the Patent Office proceedings in respect to the location of the casing, and by the rejections and acquiescence in original and as amended

Claim 3, the Patent Office decided and Smith conceded that the wheel support disclosed neither invention nor novelty, was not the distinguishing characteristic of the claim but an accessorial element involving mechanical selection, it is easy to perceive the sounder reasoning and the inapposite-ness of the cited cases by realizing that self-imposed limitations or estoppels in the Patent Office proceedings are to be marked off according to the issue therein definitely raised and determined. *Hildreth v. Mastoras*, 257 U. S. 27, 33, 34.

(b) Coming to Respondents' contention refuted by the opinion below and by the Fifth Circuit Court of Appeals, that as Respondent's casing is located on the interior outer side relative to its race course, or side facing the infield or inner oval, the location of the casing in allowed Claim 3 is reduced by estoppel to the exterior outer side or side facing the outfield or grandstand.

At no time was the location of the casing required to be restricted to the exterior outer side. The rejection was confined to the Examiner's holding that it was not invention to provide Walsh's rail track and car with a casing. In revising allowed Claim 3, the casing was claimed substantially as described in the preferred location. There was nothing in the rejections or rejected claims nor in the prior art that imposed such a limitation as contended for. Aside from the location claimed, being the one preferred by reference to the specifications and drawing (Side folio opposite R. p. 170, R. p. 172), the term "outer side" is broad enough to include either outer side as "a race course suited for dogs" comprises any shape or size desired

whether rectangular, straight-of-way or parallelistic oval having two external sides or fences oppositely disposed and constituting the race course, (as distinguished from a circular plane surface) either of which has two outer sides—right outer and left outer, as well as between which there are two inner sides—right inner and left inner.

Point D.

Patent No. 1,507,440 is valid.

(a) Albeit not specifically in issue, patentability is questioned by the opinion below. (R. p. 411; *Magic City, etc., v. Smith*, 38 Fed. (2nd) 173).

In his specification, Smith says: "My invention relates to means for concealing the track and conveyor car in a mechanical lure conveyor for dog racing courses. The object is to provide a suitable housing for concealing the track and conveyor car from the dogs and which form a continuous housing around the race course with a continuous opening upon the side towards the course". (R. pp. 178, 179). Again, "In the foregoing construction, it will be seen that the entire track and conveyor car are concealed from the dogs, the only portion being exposed to view are the arm and parts mounted thereon". (R. p. 180). Nor is the invention intended to cover or does cover housings other than for dog racing apparatus having a laterally extending arm, for each claim contains the relative and limiting introductory phrase "In a housing for covering tracks and cars having laterally extending arm operated upon said track", etc., and "in a continuous housing for concealing", etc. (Claims 1, 2, 3, R. p. 180). And further-

more, the Examiner indicated that the claims be thus confined as a basis for his consideration and allowance. (R. p. 261).

Keeping in mind this limitation, the patent relates to the casing element called for in Patent No. 1,379,224, and a result of a separate application co-pending with and divided out of that Patent Application as suggested and required by the Examiner. (R. pp. 231, 237, 239). Accordingly, it is a subcombination patent, operating conjointly as to use with those elements of Patent No. 1,379,224, in performing the subordinate interdependent function of concealment and is therefore expressly limited in its utility to perform its appropriate function in a dog racing device having a laterally extending arm and of which it forms a part. *Philadelphia, etc., R. R. Co. v. Dubois*, 12 Wall 47; *Gill v. Wells*, 22 Wall 1; *Canda v. Michigan*, 124 Fed. 486, 489, 490 (C. C. A. 6); *Thomson-Houston v. Black River, etc.*, 135 Fed. 759 (C. C. A. 2); *Thomson-Houston v. Elmira*, 71 Fed. 396 (C. C. A. 2).

Minus the expressed relation and limitation, the housing described is minus utility. That relation suggested the idea of concealment, but how and in what manner? There may be many ways for carrying it out but any manner is necessarily conjoined with the disclosure embodying the limitation, thus constituting an improvement on or addition to the original invention. (*Seymour v. Osborne*, 11 Wall. 516).

This contribution is exhibited by the Walsh Patent, which has as its fundamental element a laterally extending arm, angular though it be, yet operating on the track

in vertically inclined planes. Like Smith, he realized the necessity of concealing his mechanisms from the dogs, and he stepped in that direction, not by means of a housing but by means of a relatively high fence. As heretofore shown, Smith carried out this idea of concealment but in a radically different way, by placing his fence on the far side of the rail track and from its upper end bringing it over towards the outer side of the course, thus producing cooperation in the free movement of his arm through the longitudinal opening and that of concealing the mechanisms from the dogs. It never occurred to Walsh or to any mechanic having his patent before him to conceal his mechanisms other than by means of a fence, but the same idea of concealment occurred to Smith and he carried it out by another and different means. *Hobbs v. Beach*, 180 U. S. 383, 392, 393. So, what would have occurred to a mechanic without his exercising the inventive faculty, is clearly uncertain, inconclusive, unreliable and further complicated by speculating as to his capacities and attainments. *Hobbs v. Beach*, 180 U. S. 383, 392; *Webster Loom v. Higgins*, 105 U. S. 580; *Kremetz v. Cottle Co.*, 148 U. S. 556; *Potts v. Creager*, 155 U. S. 597, 608; *Leeds & E. Co. v. Victor, etc., Co.*, 213 U. S. 325, 332, 333; *Kurtz v. Belle Hat*, 280 Fed. 277, 281 (C. C. A. 2).

Believing that the test of invention is dependent upon objective evidence free from the influence of subjective bias, one must determine what is or what is not mechanical skill, not from what is simple and obvious after

the fact, but from what is new and useful; for it must be shown that the invented thing has heretofore been produced either in fact or communicated by publication. Slotted tubing, housings for third rail, coverings for loading platform, canopies at the entrance of hotels, theatres and residences, are not adaptable for or combine all the elements, functioning substantially in the same way as the housing in suit, or having the same objects and purposes and producing or being capable of producing the same result of covering or concealing tracks and cars having laterally extending arm operating on a dog race course (*Eibel Process Co. v. Minnesota Co.*, 261 U. S. 45, 66; *Seymour v. Osborne*, 11 Wall. 516, 542, 548; *Canda v. Michigan*, 124 Fed. 486, 492. But the opinion below seemingly rests on Bertram (R. p. 356, side folio 417-418) as an anticipation.

Glancing at Bertram's specifications and his third rail cover, it was designed with a view of protecting the third rail from the weather, snow, sleet, etc., he had no purpose of covering or concealing tracks and cars having laterally extending arm operating on a dog race course. Bertram's cover consisted of a bottom board, a vertical side board insulated, a top board and two side boards separated by a longitudinal opening, all nailed and joined together to form a continuous cover and supported integrally by reason of its small size. Ordinarily, whilst size, proportion and degree are inconsequential factors, in Bertram's cover, they are essential and functional since any increase in size, proportion or degree would be objectionable and un-

necessary. It is so small, that the rigidity of its frame is inherent in the structure, requiring no posts, timbers attached to posts, boards or truss rods adapted to support the side above the continuous opening. This furnishes an additional reason why Bertram's construction was limited to its own special purpose. Smith's housing could not stand without posts, timbers, boards and truss support of his top side.

It is argued that Smith's changes being structural, any mechanic could have done it, but, in rejoinder, such a change produces a more useful, beneficial and different result coupled with the presumption arising from the grant and the extensive use of Smith's housing in the dog racing art. *(Seymour v. Osborne*, 11 Wall. *supra; Canda v. Michigan, supra).* So Bertram's patent cannot be considered as an anticipation since it does not disclose the purpose, means and mechanism for accomplishing the end of the patent in suit, and which are restricted by Bertram's disclosure to the accomplishment only of a substantially different and limited purpose. For, accidental results, not intended and not appreciated, do not constitute anticipation. *Eibel Process v. Minnesota &c. Co.*, 261 U. S. 45, 66; *Gordon Form & Co. v. Wolcott & Co.*, 32 Fed. (2nd) 55 (C. C. A. 6), and cases there cited. *Western Electric v. LaRue*, 139 U. S. 601; *Hobbs v. Beach*, 180 U. S. 383, 392; *Tilghman v. Proctor*, 102 U. S. 707, 711.

Since, therefore, Bertram's cover was not designed by him, nor adapted nor actually used for the performance of the function of concealing lure conveyor mechanism

having laterally extending arm operating on a dog-race course, it is not anticipation that Bertram's cover might, by modification, be made to accomplish the function of the patent in suit. *Topliff v. Topliff*, 145 U. S. 156, 161; *Seymour v. Osborne*, 11 Wall. 516; *National Hollow B. B. Co. v. Interchangeable Co.*, 106 Fed. 693 (C. C. A. 8); *Canda v. Michigan*, 124 Fed. 486 (C. C. A. 6); *Wayne v. Benbow Brammer*, 168 Fed. 271, 277. Nor does it constitute anticipation and no defense to a claim for infringement, that one or more parts of a patented improvement may be found in one old patent or publication, and others in another and still others in a third. It is indispensable that all of them or their mechanical equivalents be found in the same description or machine, where they do substantially the same work by substantially the same means. *Bates v. Coe*, 98 U. S. 31, 48; *Imheuser v. Buerk*, 101 U. S. 647, 660; *Seabury v. Am. Ende*, 152 U. S. 561, 568; *Hobbs v. Beach*, 180 U. S. 383. And as "that which infringes if later, will anticipate if earlier", Bertram would not infringe on Smith for he omits every element of the claim except boards and the longitudinal opening.

(b) Turning to the File Wrapper (R. pp. 254 to 271) this claim (R. p. 263) was allowed and remained allowed at all times. The rejections of other claims had no limiting effect as to this Claim 1. Original Claims 1 to 4 (R. pp. 258, 259) were rejected as indefinite and as aggregatious, and the Examiner suggested amendment so as to confine them to a housing for covering or concealing the car having a laterally extending arm. (R. pp. 261, 262). Conformably to the suggestion, four new claims were presented (R. pp. 262, 263, 264). New Claim 2

(being Claim 1 of the Patent) was allowed. (R. pp. 266, 267). New Claims 1, 3, and 4 were rejected on Bertram (R. p. 266), cancelled (R. p. 267) and amended new claims 2 and 3 presented (R. p. 267). As thus amended, these new Claims 2 and 3 were allowed and Claim 2 (Claim 1 of Patent) again allowed. (R. p. 268).

Inserted amended Claims 1 and 4 rejected on Bertram, as in Bertram, made no provision different from Bertram for supporting any side of the housing (R. p. 356, Defendants' Exhibit No. 21, side folio 417-418); inserted or Amended Claim 3 broadly claimed "means for supporting" etc., whereas Bertram's means of support was integral in his cover by virtue of its size, or by his inverted L-shaped third rail functioning accidentally as a bracket. (See b, b^2, Fig. 1 of drawing, side folio 417-418 opposite R. p. 356). So that, on the cases cited in our discussion of File Wrapper of Patent 1,379,224, the estoppel as to allowed claims previously rejected on Bertram is, that Smith is estopped from maintaining that these amended claims as allowed, cover Bertram's combination, or from now claiming that these claims have the same breadth as the amended and rejected Claims 1, 3 and 4, namely, that the support of the side above the continuous opening is integral in the structure or by means of a bracket which, of course, has no truss function. Nowhere in Bertram is a truss function discernable or even suggested; nor is it pretended that the side of Respondents' housing above the continuous opening is supported as in Bertram, nor that Respondents are using Bertram's cover. *Griswold v. Harker*, 62 Fed. 389, 393 (C. C. A. 8); *Imperial Machine v. Blakeslee*, 262 Fed. 419, 423 (C. C. A. 2).

Point E.

Respondents have infringed Claim 1 of Patent No. 1,507,440.

(a) In letter and substance, Respondents' housing reads directly on this Claim (R. pp. 120, 122, 127, 128, 138, 139, 142, 143, 144, 145, 154, 155, 159, 168, 187. Plaintiff's Exhibit No. 5 side folio 177-178; Plaintiff's Exhibit No. 7, side folio 179-180; R. p. 180). The opinion below adopts the word "cleat" to designate the member which the claim designates a "truss rod", from which the Court concludes that respondents do not infringe. This wooden rod or "cleat" is attached to the closed or rear side of the housing and is adapted to support the side of the housing above the continuous opening by being fastened to an overhanging beam in continuation of the side above the continuous opening, denominated cantilever, and producing a triangular tie or truss—a cantilever truss. As the claim reads "truss rods adapted to support, etc." it comprises every kind of truss construction. *(Webster's New Int. Dict.* (Merriam Ed.) 1927, *verbo* Truss in Arch-Engin.). There is substantial identity of function, operation and result. *Sanitary Ref. Co. v. Winters*, 180 U. S. 30; *Smith v. American Electr. Rabbit, etc.*, 21 Fed. (2nd) 366, 372, 373, 374.

(b) In the Courts below, Respondents asserted an interpretation of Claim 1, contending that element 4 reading "a continuous opening in one side of said housing adapted to permit extension of the laterally extending arm

therethrough" should be read as an opening in the side wall as distinguished from a space between the side wall and the roof. Assuming, for the time being, that that construction is to be placed on plain language, nevertheless on the facts found by the Master, approved by the District Court (and not questioned by the Tenth Circuit Court of Appeals) Respondents' device falls within it. (See Masters Report R. pp. 89, 90, 91, 92; R. p. 116). On the other hand, the language rejects that interpretation, which would result in striking out an unambiguous clause, insert words not contained therein and thus, in effect, would make it easy to escape infringement by such an evasion as elevating or lowering the grade of rail tracks and course or the height and size of the conveyor car and continuous opening in the face of the specifications which read: "with the foregoing and other objects in view, my invention consists of the arrangement and combination of parts as hereinafter described and claimed; and while the invention is not restricted to the exact details of the construction disclosed herein, yet for the purpose of illustrating a particular embodiment thereof, reference is had to the accompanying drawings" (R. p. 179). For structures designed to evade the spirit of the invention and which contain all the elements of the claim are infringements. *Walker on Patents*, 6th Edition, Sec. 424, Vol. 1, p. 520. That rule is likewise applicable to Respondents' contention that they have avoided infringement in their support of the side above the continuous opening by using truss rods so assembled as to form a rigid frame work, whether cantilever truss or any other kind of truss, conformably to claim language.

Point F.

The decision below reversing the decree of the District Court is erroneous.

Reversal of the decree and dismissal of the bill by the Tenth Circuit Court of Appeals, operated an annulment of the judgment for $20,000.00 stipulated damages and a cancellation of the stipulated damage bond by the terms of the order withholding the temporary injunction (R. pp. 44, 45) and the condition of the bond. (R. p. 46). The opinion below goes further and finds, that in any event, the judgment and bond for such stipulated damages are void as serving a subterfuge for a judgment for gambling profits or concessions. (R. p. 415, *Magic City, etc., v. Smith*, 38 Fed. (2nd) 170, 175). There being no evidence to warrant it, nothing in the order or decree of the District Court to sanction it, confessedly, our faculty of perception is dissipated. The stipulation is limited to petitioner's damages, not to Respondents' profits. It covers her lost royalties and such other resulting damages. The matter of Respondents' profits derived from the use of the infringing device, is left open by the decree of the District Court for an accounting, and should it hereafter or at any time appear that Respondents are profiting by any illegal act of theirs, that is no concern to petitioner; it is outside the stipulation, outside the relief prayed for.

It is respectfully submitted that the decision and decree of the Tenth Circuit Court of Appeals be reversed.

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Administratrix, Petitioner.